

REMARKS

This amendment demonstrates that the rejection of the claims in the final rejection of July 10, 2008 is not warranted and must be withdrawn. No new issues are presented after final rejection requiring the examiner's further consideration or search.

This application is properly entitled to the benefit of a provisional application filing date that precedes the effective date of one of the two primary references cited in the rejections under 35 U.S.C. §103, namely published application US 2004/0130572 – Bala. In response to the previous official action, before the Bala reference was first cited of record by the examiner, applicant amended the specification to insert a cross reference to provisional application SN 60/399,834, filed July 31, 2002. Applicant also submitted an application data sheet mentioning said provisional application.

Applicant's amendment of the specification and the application data sheet seem to have been overlooked in the most recent official action. Moreover, the action contains new prior art rejections, all relying on newly cited US 2004/0130572 – Bala.

The Bala published application does not predate applicant's provisional application filing date.

Applicant now submits a supplemental Declaration by the inventors containing a claim to the priority of the provisional application. Upon review of the rules, it appears that the amendment to insert the claim of priority to the provisional application, which was part of applicant's amendment filed April 14, 2008, may require a petition under 37 C.F.R. §1.78(c). Applicant submits such a petition concurrently herewith. The petition meets the requirements of 37 C.F.R. §1.78(c)(1), (2) and (3).

The pending claims stand rejected under 35 U.S.C. §103 over combinations that all rely on two references, namely US Patent 4,785,408 - Britton and US published application 2004/0130572 – Bala, the latter being newly cited.

Britton is considered to disclose a system and method for composing interactive telephone dialogs using modular elements that the configuror (the human programmer) selects in a sequence and configures using an operator interface process running on a processor.

Bala is cited in the official action in combination with Britton, for modifying Britton's process to include a programming wizard, as stated in the claims. A programming wizard operates in this context to assist the human configuror when prompted to make selections. The responses of the configuror, entered via the operator interface, are used by the wizard to constrain the subsequent choices that are offered to the human configuror. The wizard enables the configuror to assemble an operational dialog using the processor, even though the configuror may not understand the behaviors and interactions of the dialog components. The finished dialog is bound to work, because the wizard-controlled process offers only those alternatives and only accepts those choices that lead to an operational dialog.

A rejection under 35 U.S.C. §103 based on a combination of Britton and Bala cannot be maintained due to applicant's provisional application SN 60/399,834, filed July 31, 2002. Bala is not dated to a time before applicant's invention, which is at least as early as the filing date of the provisional application. Bala was not published more than one year before applicant's filing date. Upon grant of the accompanying petition, Bala is not citable under 35 U.S.C. §102(e)¹. Inasmuch as Bala does not meet any part of 35 U.S.C. §102, Bala cannot be cited in combination with Britton or other prior art under 35 U.S.C. §103. The rejection is without proper support and must be withdrawn.

The claim to the priority of the provisional application is submitted after the time period of 37 C.F.R. §1.78(b)(4), which ran to November 30, 2003. The accompanying petition establishes that the delay in submitting the reference to the provisional application was unintentional, and includes all requirements for a grantable petition: The reference to the provisional has been added. The petition fee is paid. The petition includes the required statement that the entire delay was unintentional.

The present application was filed within one year after the provisional filing date. This application and its provisional have common inventorship and subject matter. The

¹ Apart from the petition, the provisional application also establishes the fact of applicant's invention prior to the Bala filing date and would constitute evidence for swearing behind Bala under 37 C.F.R. §1.131.

disclosure in the provisional application supports the aspects by which the claimed invention patentably distinguishes over Britton.

The provisional application was filed **July 31, 2002**, prior to the effective date of Bala as a reference. Bala is citable as a reference as of Bala's application filing date, **January 7, 2003**, under 35 U.S.C. §102(a) or §102(e). Bala is not prior art.

The 35 U.S.C. §103 rejections of applicant's claims cannot be maintained. The prior art that predates the provisional application (i.e., Britton), and the level of ordinary skill in the art, for reasons already argued at length in this application, do not show that the claimed invention would have been obvious. There is no reason to consider it probable that any particular improvement or benefit might likely be obtained by using programming wizards in the specific context of constraining the composition of telephone dialogs, when the composition involves sequencing and configuring already-modular dialog units into operational dialogs. The person of ordinary skill on July 31, 2002 would not have believed it probable that adding a wizard to Britton would achieve any particular benefit.

Certain of the claims were rejected over the combination of Britton and Bala in further combination with US Patents 7,003,079 – McCarthy or 6,850,603 – Eberle. These rejections also rely on Bala, and cannot be maintained for the same reasons stated above.

The application is in condition for allowance. Applicant requests withdrawal of the new prior art rejections raised in the final action, and allowance of claims 42-70.

Respectfully submitted,

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